

REMARKS

Claims 1 and 3 through 26 are pending in this Application, of which claims 14 through 21 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). Applicants acknowledge, with appreciation, the Examiner's indication that original claims 2 and 4 through 8 contain allowable subject matter.

Claims 1, 11 and 12 have been amended and claims 22 through 26 added. Care has been exercised to avoid the introduction of new matter. Specifically, the limitations of claim 2, indicated allowable, have been incorporated into claim 1, and limitations corresponding to those present in original claim 2 have been incorporated into independent claims 11 and 12. Consequently, claim 2 has been cancelled. Claims 22 and 23 basically correspond to original claims 4 and 5, respectively, each indicated allowable, now presented in independent form. New claims 24, 25 and 26 basically correspond to original claims 6, 7 and 8, respectively, now made dependent upon new claim 23. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 1, 3, 9, 10, 12 and 13 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Takase (JP05-048098)¹ in view of Brigham et al.

This rejection is traversed. Indeed, this rejection has been rendered moot by incorporating the limitations of claim 2, indicated allowable, into independent claim 1, and by amending claim 12 by incorporating limitations similar to those present in original claim 2. Indeed, the Examiner implicitly recognized that Takase neither discloses nor suggests a semiconductor device corresponding to those defined in independent claims 1 and 12 comprising, *inter alia*, a gate electrode or first conductive layer which includes an upper surface

¹ In the Office Action the Examiner used the first name of the inventor, Rikio, rather than the last name, Takase.

having a reverse mesa shape and a lower portion having a forward mesa shape. Accordingly, even if the applied references are combined as suggested by the Examiner, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicants, therefore, submit that the imposed rejection of claims 1, 3, 9, 10, 12 and 13 under 35 U.S.C. § 103 for obviousness predicated upon Takase et al. in view of Brigham et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Claim 11 was rejected under 35 U.S.C. § 103 for obviousness predicated upon Takase et al.

This rejection is traversed. As previously noted, limitations similar to those appearing in original claim 2, indicated allowable, have been incorporated into claim 11. Accordingly, this rejection has been rendered moot. Indeed, as acknowledged by the Examiner, Takase neither discloses nor suggests a semiconductor device as defined in claim 11 comprising, *inter alia*, a gate electrode which includes an upper portion having a reverse mesa shape and a lower portion having a forward mesa shape. Accordingly, even if Takase's device is modified as suggested by the Examiner in the statement of the rejection, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, *supra*.

Applicants, therefore, submit that the imposed rejection of claim 11 under 35 U.S.C. § 103 for obviousness predicated upon Takase is not factually or legally viable and, hence, solicit withdrawal thereof.

New claims 22 through 26.

New claims 22 through 26 are clearly free of the applied prior art. As previously mentioned, new independent claims 22 and 23 basically correspond to original claims 4 and 5, respectively, in independent form, claims 4 and 5 having been indicated to contain allowable subject matter. Claims 24 through 26 basically correspond to original claims 6, 7 and 8, respectively, dependent upon claim 23, claims 6, 7 and 8 having also been indicated to contain allowable subject matter. Accordingly, claims 22 through 26 are clearly free of the applied prior art.


Applicants again acknowledge, with appreciation, the Examiner's indication that original claims 2 and 4 through 8 contain allowable subject matter. Based upon the arguments submitted *supra*, it should be apparent that the imposed rejections have been overcome and that all active claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Application No.: 10/671,458

Respectfully submitted,

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